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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/414,281 03/31/95 OVADIA

BSM2/0404

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V OVVA-2-1-279

SHEPPERD, J. EXAMINER

ART UNIT PAPER NUMBER

2514

DATE MAILED: 04/04/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |                                                                                         |                                                                                   |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____                                                 |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-26 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☒ Claims 1-16, 18-20 are allowed.
4. ☒ Claims 17 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. The specification and declaration have different titles. The title in the specification is "Discount Offer Redemption System and Method" the title in the declaration is "System And Method For Product Extension." The title in the specification clearly better describes the invention which is a discount redemption system. As the examiner has no idea how "product extension" relates to the invention disclosed in the specification or what "product extension" might mean, a new or supplemental declaration identifying this application should be submitted. The very different titles raise the question of whether applicant inadvertently filed the wrong declaration with this application. The prior art statement uses the product extension title but is clearly directed towards the disclosed discount redemption system. Applicant should change the title to the title given in the specification.
2. On line 4 of the first page of the specification the patent number given was incorrect. The number has been changed to 5,308,118 which is Mr. Ovadia's patent.
3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claim 17 is rejected under 35 U.S.C. § 103 as being unpatentable over either the well known prior art, the "Eyeing the consumer" article or Dinerstein 4,872,113 in view of the disclosed prior art in Tai. Safeway stores has for several years had a "Safeway Club" promotion which grants discounts on selected

items to people using a card which identifies them. One of the benefits to the store is the ability to collect buying habits of individuals. In lines 15+ of the third column on page 63 of Eyeing the consumer the article states that stores are using store debit cards to identify buying habits of individuals. Dinerstein disclose the same system using checks as the identifying medium rather than a card. In column 2 lines 56+ of Tai, Tai notes that individually coded coupons were known which allowed the identification of who actually redeemed the coupons. It would have been obvious to have also used the prior art coupons which identified individuals to identify the purchaser and purchased products in the Safeway club, the system disclosed in Eyeing the consumer or, Dinerstein in addition to checks or cards because that would allow more individual buying habits to be collected. A person may use a coupon but not use a check, debit card or Safeway club card. Some consumers are reluctant to join such clubs because of the perceived loss of privacy.

5. Claims 1-16 and 18-20 are allowed. The prior art does not teach or suggest coding a circular such that the code can be scanned and retrieve all articles having discounts in that circular. The closest prior art appears to be the above noted Safeway club but, the circulars are not coded and, it is the card that is scanned. As only one set of items at a time are discounted for club members there is no reason to code the circular. Coupons themselves are coded but they contain all the

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information required for redemption and do not need to retrieve anything from memory.

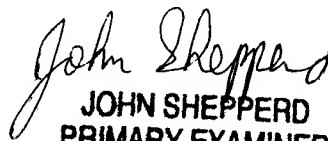
6. Metts 5,369,571 disclose a system to collect demographic data with purchases that does not require a card check or the like as the operator merely enters demographic data with the transaction.

7. Silverschotz et al 5,137,304 discloses a individually coded coupon.

8. Pruchnicki 5,185,695 disclose a paperless coupon system that has a coupon list file. However, there is only one file as in the Safeway club and, there is no need for a coded circular to address one of several files.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Shepperd whose telephone number is (703) 308-0091.

John Shepperd  
March 29, 1996

  
JOHN SHEPPERD  
PRIMARY EXAMINER  
GROUP 2500

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Attachment 4

**The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsman at this time. When formal drawings are submitted, the draftsman will perform a review.**

**Direct any inquiries concerning drawing review to the Drawing Review Branch (703) 305-8404.**